



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,298	01/29/2001	Herve Cunin	G-74	8603

21839 7590 10/26/2004

BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

STEVENS, THOMAS H

ART UNIT	PAPER NUMBER
----------	--------------

2123

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,298

Applicant(s)

CUNIN, HERVE

Examiner

Thomas H. Stevens

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4 were examined.

Response to Arguments

Abstract

2. The applicants are thanked for addressing this issue; objection is withdrawn..

Priority Document

3. The applicants are thanked for addressing this issue. The office has received the document, thus acknowledging priority under 35 U.S.C. 119(b).

Drawings

4. The applicants are thanked for addressing this issue. The examiner comprehends applicants' reasoning regarding ISO-7816-4 cases 1 and 3 missing from the drawings. The objection is withdrawn.

Claim Rejections - 35 USC § 112

5. The applicants are thanked for addressing this issue. The examiner comprehends applicants' response regarding the reasoning of omission of cases

Art Unit: 2123

1 and 3. However, it's the position of the examiner that details to all of ISO-7816-4 should have been stated (i.e., background) within the specification to avoid misunderstandings. Contrary to the applicants' stating, "it is not necessary to describe these cases in detail within the specification" (pg. 6, line 18), the examiner believes it is in the best interest of the public to disclose or mention ancillary facts linked to the invention regardless if it is well known within the art.

Furthermore, the specification is not written in the preferred form (as stated below). Thus the rejection stands under 112 1st; however, rejection under 112 2nd is withdrawn based on applicants' amendment.

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

Art Unit: 2123

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH
OR DEVELOPMENT.

(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON
A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05.
Computer program listings (37 CFR 1.96(c)), "Sequence Listings"
(37 CFR 1.821(c)), and tables having more than 50 pages of text
are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP §
608.05(a). "Microfiche Appendices" were accepted by the Office
until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under
37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE
DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate
sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A
"Sequence Listing" is required on paper if the application discloses

Art Unit: 2123

a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

7. The applicants are thanked for addressing this issue. Applicant's arguments with respect to the rejections of claims 1-4 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection by Europay International in view of Renner et al. (U.S. Patent 5,679,945).

Rejections

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The application does not define what case 2 and 4 are. Furthermore, case 1 and 3 are missing.

Art Unit: 2123

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner is unclear of notation "(c₁)".

Claim Rejections - 35 USC § 103

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

Art Unit: 2123

the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-4 are rejected under 35 U.S.C. 103 (a) as unpatentable by Europay International S.A. ("Integrated Circuit Card Specification for Payment Systems" (1995)), in view of Renner et al., (U.S. Patent 5,679,945 (1997)).

The Euorpay International S.A. (EISA) teaches data elements and commands to the exchange of information between and integrated circuit card and a terminal (pg.1-1, lines 1-3) based on ISO/IEC 7816 series of standards (pg. 1-1, 5th paragraph); but doesn't teach an emulation process. Renner et al. teaches an intelligent card reader to replace existing magnetic strip readers, bar code, bar code readers and Wiegand effect readers without the need for expensive retrofitting of existing computer systems which are coupled to the existing readers (abstract), while supplying various emulation features (column 5, lines 65), which are use well know ISO standards (column 8,lines 59-61).

At the time the invention, it would have been obvious to one of ordinary skill in the art to use Renner et al. to modify (EISA) since it would be advantageous to mimic routine transactions while retrofitting the operational code for full optimization.

Art Unit: 2123

Claim 1. A method of emulating a chip card reader (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5) functioning according to the PSCS standard (Renner: column 8, lines 58-61; and EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) in order to manage a chip card reader functioning according to the EMV standard and communicating with the chip card according to the protocol T= 0, (EISA: pg. 6-3, section 6.1.3 with table 4) comprising the following steps: (a) determining the types of APDU exchanges for which emulation is to be effect (EISA: pg. 6-3, section 6.1.3 with table 4); (b) emulating the return of a state word in compliance with the standards of the PCSC environment (EISA: pg. 6-7, section 6.4); (c) when the type of APDU exchange corresponds to a Case 2 as defined in ISO 7816-4 (EISA: pg. 6-3, section 6.1.3 and 6.2.1) receive the command C-APDU complying with the state word (EISA: pg. 6-3 through 6-4 with table 6); (d) when the type of APDU exchange corresponds to a case 4 as defined in the standards (EISA: pg. 6-3, section 6.1.3), receiving the command GET-REPONSE using the state word; (e) returning R-APDU in response to C-APDU or to GET-RESPONSE (EISA: pg.6-12, section 6.5.3).

Claim 2. A method according to Claim 1, (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5; EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) wherein the operations (c) and (d) are in reverse order (EISA: pg. 6-1, paragraphs 2 and 3).

Art Unit: 2123

Claim 3. A method according to Claim 1, (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5; EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) wherein the operation (c) (EISA: pg. 6-1, paragraphs 2 and 3) is followed by the following step: (c₁) emulating the return of a state word, complying with the standards of the PCSC environment as provided for when the type of APDU exchange corresponds to a case 4 (Renner: column 7, lines 51-67 with EISA: pg. 6-3, section 6.1.3 with table 4).

Claim 4. A method according of emulating a chip card reader (Renner: emulation section—column 5, lines 65-67 through column 8, lines 1-5) functioning according to the PSCS standard (Renner: column 8, lines 58-61; and EISA: pg. 5-2, section 5.4.1 with 5.2.1 and 5.2.2) in order to manage a chip card reader functioning according to the EMV standard and communicating with the chip card according to the protocol T = 0, comprising the following steps: determining the types of APDU exchanges for which emulation is to be effected, emulating an alarm state (EISA:pg. 6.4 through 6-5, "warning processing"; and Renner: column 8, lines 54-67), which can relate to the application of the chip card, and sending to the PCSC environment the state word complying with the standards of the PCSC environment (Renner: column 7, lines 51-67 with EISA: pg. 6-3, section 6.1.3 with table 4), when the type of APDU exchange corresponds to a case 2 as defined in ISO 7816-4, receiving the command C-APDU complying with the state word, receiving the command GET-RESPONSE (EISA: pg.6-12, section 6.5.3) parameterized such that the number of bytes awaited is 0 (EISA: pg. 6-4,

Art Unit: 2123

section 6.2.3), and emulating a state word, (EISA: section 6.2.2) complying with the standards, to the PCSC environment as provided for when the type of APDU exchange corresponds to case 4.

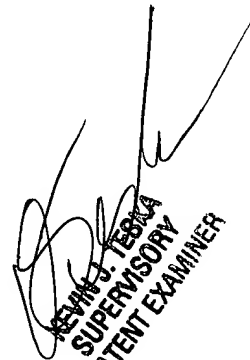
Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Stevens whose telephone number is (703) 305-0365, Monday-Friday (8:30 am- 5:30 pm) or contact Supervisor Mr. Kevin Teska at (703) 305-9704. The fax number for the group is 703-872-9306.

Any inquires of general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 305-3900.

October 19, 2004

THS


KEVIN. TESKA
SUPERVISORY
PATENT EXAMINER